REMARKS

Claims 38-63 were originally presented for examination by two Preliminary Amendments. Of those claims, claims 38 and 46 were independent claims.

The first and second Official Office Actions were not actions on the merits. They were requirements for restriction and election of species. As a result of compliance with those requirements the Group I claims 38-45 and 51-58 drawn to a process for extracting a "compound" generally was elected, and the following species were elected:

A. the flavored composition material extracted;
B. 1,1,1,2,3,3,3-heptafluoropropane as the solvent; and
C. the C_{2-4} alkane as the cosolvent.

As a result of those elections, claims 38-40, 51, 53, 56 and 57 remained in the case to be examined as elected claims prior to the last Office Action - - the third Office Action and the first one on the merits.

In the last Office Action those claims have now been acted upon as well as previously nonelected species claims 52, 54 and 55 because it is asserted that at least some of the prior art also discloses the subject matter of the latter previously nonelected species claims. Thus, claims 38-40 and 51-57 have been addressed on the merits in the last Office Action.

In the last Office Action, all of those last mentioned claims have been rejected as follows:

A. Claims 38-40, 51 and 56 have been rejected under 35 USC §102(e) as lacking novelty over WILDE (5,512,285); and

B. Claims 38, 39, 51-56 and 57 have been rejected under 35 USC §102(b) as lacking novelty over SMITH (GB 2 225 205 A).

Claim 56 was also objected to as being dependent on a non-elected claim. However, like other dependent claims 51-55 to which no objection was taken, claims 56 depends either from claim 38 or claim 46, and claim 38 is an elected claim. Thus, we do not understand the objection to claim 56. In any event, dependent claim 56 as well as dependent claims 51-55 have been amended hereto to only depend from elected claim 38. Accordingly, any and all objections directed to dependency from a non-elected claim should be obviated.

The sole elected independent claim 38 has been amended to set forth that the extraction process uses an extraction solvent comprising a C_{1-3} hydrofluorocarbon selected from difluoromethane, pentafluoroethane and the hydrofluoropropanes and a cosolvent "which is not a (hydro)fluorocarbon." WILDE contains no disclosure or suggestion whatsoever of a C_{1-3} hydrofluorocarbon together with a cosolvent "which is not a (hydro)fluorocarbon."

Amended claim 38 is also clearly inventive over WILDE as there is no teaching or suggestion whatsoever therein to provide an extraction process that uses an extraction solvent and a co-solvent as defined in amended claim 38.

SMITH discloses a process for reducing the oil content of oil rich snack foods such as potato crisps using a liquefied gas as the solvent. SMITH lists suitable compounds for use in the method it describes in Table 1 on page 5.

Amended claim 38 is clearly novel over the disclosure of SMITH because SMITH does not disclose a process that uses an extraction solvent comprising a C_{1-3} hydrofluorocarbon selected from difluoromethane, pentafluoroethane and the hydrofluoropropanes and a cosolvent which is not a (hydro)fluorocarbon.

The list of solvents in Table 1 of SMITH does include difluoromethane and some hydrofluoropropanes, as well as some (hydro)fluorocarbons. However, this is not an explicit disclosure of an extraction solvent as defined in amended claim 38 that comprises a C_{1-3} hydrofluorocarbon selected from difluoromethane, pentafluoroethane and the hydrofluoropropanes and a cosolvent which is not a (hydro)fluorocarbon.

SMITH only really discloses a process that uses propane as the extraction solvent. There is no explicit disclosure or experimental data in SMITH relating to the use of any extraction solvent other than propane on its own. The list of solvents provided in Table 1 of SMITH is merely speculative and cannot be considered to be a disclosure of a process that uses an extraction solvent that comprises a C_{1-3} hydrofluorocarbon together with a cosolvent which is not a (hydro)fluorocarbon.

The emphasis and examples in SMITH using propane is entirely as expected since the skilled person would have known from his common general knowledge that the oils used to cook snack foods are hydrocarbon-like in character and, as such, will tend to have good compatibility with the solubility in hydrocarbon solvents such as propane. The skilled person would, therefore, have concluded, from his understanding of what makes one material soluble in another, that the hydrocarbon-like oils used to cook snack foods would only be poorly soluble in C_{1-3} hydrofluorocarbon solvents. As such, he

would not have looked to use C_{1-3} hydrofluorocarbon solvents in the de-oiling process taught in SMITH because he would not expect such solvents to be particularly good at dissolving and removing the oil. Moreover, the skilled person would not have considered using C_{1-3} hydrofluorocarbon solvents in combination with a cosolvent which is not a (hydro)fluorocarbon. Thus, amended claim 38 is clearly inventive over SMITH.

The only teaching in SMITH with respect to using mixtures of extraction solvents is in claim 6. However, claim 6 of SMITH does not disclose a mixture including the C_{1-3} hydrofluorocarbons as defined in amended claim 38. And, claim 6 of SMITH certainly does not disclose a mixture of such C_{1-3} hydrofluorocarbons and a co-solvent that is not a (hydro)fluoropropane.

If the skilled person applied the teaching of claim 6 to combine two or more of the solvents listed in that claim, the number of mixtures he could arrive at would be practically infinite. Additionally, if he considered Table 1 to be more than a speculative disclosure and combined two or more of the solvents listed in that Table, he could make a vast number of mixtures. Although some of these mixtures may conceivably fall within the terms of amended claim 38, this cannot be considered to be a new explicit disclosure of an extraction solvent that comprises a C_{1-3} hydrofluorocarbon and a co-solvent which is not a (hydro)fluorocarbon.

New dependent claim 64 has been added which depends from claim 38 and which sets forth that the extract is a "natural product". This language finds basis in claim 57 which was rejected in the last Office Action. It is respectfully submitted that both claims 57 and 64 which set forth that the extract is a "natural product" and claim 57 which further sets forth that the natural product is "a flavored or aromatic composition" clearly define over the

cooking oil which is extracted by SMITH. The cooking oil is neither a "natural product" nor "a flavored or aromatic composition".

In paragraph 3 of the last Office Action it was indicated that the following would be allowable if presented together in a claim:

a. a C_{2-4} alkane as the cosolvent with 1,1,1,2,3,3,3-heptafluoropropane[1]; and

b. a C_{2-6} hydrocarbon, a dialkylether, dimethyl ether, and butane as the cosolvent with 1,1,1,2,3,3,3-heptafluoropropane.[1]

New dependent claims 65 and 66 have been added which depend from claim 38 and which set forth that allowable subject matter. Accordingly, claims 65 and 66 should also clearly be allowable.

For the above reasons, it is respectfully submitted that all of the elected claims remaining in the application, claims 38-40, 51-57 and 64-66, are in condition for allowance. Accordingly, favorable reconsideration and allowance are requested.

Respectfully submitted,

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[1]"1,1,2,3,3,3-heptafluoropropane" is actually stated in the Office Action, but that appears to be a typographic error.